

**REMARKS UNDER 37 CFR § 1.111**

**Formal Matters**

Claims 1, 12, 13, 46, 53, 58, 190-192 and 194-216 are pending after entry of the amendments set forth herein.

Claims 1, 12, 13, 46, 53, 58, 190-192 and 194-216 were examined. Claims 1, 12, 13, 46, 53, 58, 190-192 and 194-216 were rejected.

Applicants respectfully request reconsideration of the application in view of the amendments and remarks made herein.

No new matter has been added.

**The Office Action**

**Claims Rejected Under 35 U.S.C. Section 112, Second Paragraph**

In the Official Action of October 10, 2006, claims 194, 195, 198, 199 and 201 were rejected under 35 U.S.C. Section 112, second paragraph as being indefinite. The Examiner noted that claim 194 had not been amended to reflect the cancellation of claim 193 and thus depended upon a canceled claim. In response thereto, Applicants have amended claim 194 above to depend from claim 190. In view of this amendment, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 194, 195, 198, 199 and 201 under 35 U.S.C. Section 112, second paragraph, as being indefinite, as being no longer appropriate.

**Claims Rejected On the Ground of Nonstatutory Double Patenting (U.S. Patent No. 6,743,169)**

Claims 1, 12, 13, 53, 58, 190-192, 194-214 and 216 were rejected on the ground of nonstatutory double patenting over claims 1-4, 6-13, 17, 20-26, 31 and 32 of U.S. Patent No. 6,743,169. Although the claims are not identical, the Examiner asserted that the patent claims include more elements and are more specific, such that the patent claims are in effect a "species" of the currently rejected claims.

Although Applicants do not necessarily agree with this ground of rejection and thus do not acquiesce thereto, Applicants are nevertheless submitting a terminal disclaimer concurrently with this response in order to advance the prosecution of the instant application. Accordingly, in view of the submission of the terminal disclaimer, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 1, 12, 13, 53, 58, 190-192, 194-214 and 216 on the ground of nonstatutory double patenting over claims 1-4, 6-13, 17, 20-26, 31 and 32 of U.S. Patent No. 6,743,169, as being moot.

**Claim Rejected On the Ground of Nonstatutory Double Patenting (U.S. Patent No. 6,346,077)**

Claim 215 was rejected on the ground of nonstatutory double patenting over claim 1 of U.S. Patent No. 6,346,077. Although the claims are not identical, the Examiner asserted that the patent claim includes more elements and is more specific, such that the patent claim is in effect a “species” of the currently rejected claim. Although Applicants do not necessarily agree with this ground of rejection and thus do not acquiesce thereto, Applicants are nevertheless submitting a terminal disclaimer concurrently with this response in order to advance the prosecution of the instant application. Accordingly, in view of the submission of the terminal disclaimer, the Examiner is respectfully requested to reconsider and withdraw the rejection of claim 215 on the ground of nonstatutory double patenting over claim 1 of U.S. Patent No. 6,346,077, as being moot.

**Claims Rejected On the Ground of Nonstatutory Obviousness-Type Double Patenting (U.S. Patent No. 6,743,169)**

Claim 46 was rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,743,169 in view of Vierra et al. (U.S. Patent No. 5,749,892). The Examiner noted that claim 1 of U.S. Patent No. 6,743,169 does not include the limitation that the contact member is malleable, but asserted that Vierra et al. shows a device for use in cardiovascular surgery comprising contact members 15,17 made of malleable material. The Examiner referred to column 9, line 11 of Vierra et al. Applicants respectfully traverse the Examiner’s interpretation of Vierra et al. The portion of Vierra et al. referred to by the Examiner (column 9, line 11) discloses that foot 11a is made of a flexible material, such as rubber, so that the annular ring 100 can be collapse for introducing it through a small percutaneous incision or cannula. When used to describe materials, the term “malleable” refers to ductility or the property of being deformable, such as by

bending, hammering or rolling, and then maintaining the deformed shape. As such, this property is distinct from the flexibility that a rubber possesses, since after bending the annular ring to deliver it through the small opening, the ring then expands back into its original circular shape, see column 9, lines 17-19. Accordingly, it is respectfully submitted that Vierra et al. does not teach a foot formed of a malleable material. Further, since a terminal disclaimer is already being submitted with respect to U.S. Patent No. 6,743,169, it is respectfully submitted that this ground of rejection is now moot.

Accordingly, in view of the submission of the terminal disclaimer, and the above remarks, the Examiner is respectfully requested to reconsider and withdraw the rejection of claim 46 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,743,169 in view of Vierra et al. (U.S. Patent No. 5,749,892), as being moot.

#### **Claim Rejected Under 35 U.S.C. Section 102(e) (Vierra et al.)**

Claim 216 was rejected under 35 U.S.C. 102(e) as being anticipated by Vierra et al. (U.S. Patent no. 5,749,892). The Examiner asserted that Vierra et al. shows a device for use in cardiovascular surgery on a beating heart comprising a shaft member 3 and continuously adjustable contact members 15, 17 which may be adjusted to a shape to conform a contact surface of the contact member to a surface of the heart. Applicants respectfully traverse. It is respectfully submitted that Vierra et al. does not disclose a device for use in cardiovascular surgery on a beating heart, as Vierra et al. clearly describes that the heart must be stopped to perform the described functions with the described device.

Further, it is respectfully submitted that Vierra et al. does not describe the arms 15, 17 or contact surfaces 27 as being adjustable to a shape to substantially conform a contact surface of said contact member to a surface of the heart. Rather, Vierra et al. describes at column 6, line 66 – column 7, line 8, that the contact surfaces 27 preferably have a curvature selected to approximately conform to the outer surface of the heart, and thus usually extend along an arc of a circle having a radius between 2-10 cm. Vierra et al. further discloses alternative embodiments that may be shaped to conform with other organs or tissue structures. However, Vierra et al. does not disclose or suggest adjusting the shape of any one embodiment to change its shape so as to conform to the surface of a different organ than that which it was designed for.

Column 9, lines 10-19 describe an elastomeric, ring shaped foot that can be deformed so as to be passed through a cannula. However, after being passed through the cannula, the annular foot returns to its original shape. There is no disclosure of adjusting the shape of this foot to conform to the surface of

the heart. However, in order to still more clearly define the present invention over this embodiment, claim 216 has been amended above to further recite that the at least one continuously adjustable contact member has a memory capability to maintain the adjusted shape to substantially conform to the surface of the heart. It is respectfully submitted that Vierra et al. clearly discloses that the annular ring has no such memory.

Accordingly, in view of the above amendments and remarks, the Examiner is respectfully requested to reconsider and withdraw the rejection of claim 216 under 35 U.S.C. 102(e) as being anticipated by Vierra et al. (U.S. Patent no. 5,749,892), as being no longer appropriate.

#### **Claim Rejected Under 35 U.S.C. Section 102(e) (Flom et al.)**

Claim 215 was rejected under 35 U.S.C. 102(e) as being anticipated by Flom et al. (U.S. Patent no. 5,904,711). The Examiner asserted that Flom et al. shows a device for use in cardiovascular surgery comprising means 160 for stabilizing a beating hear that comprises a contact member 142,144 made of a shape memory material. The Examiner referred to column 13, line 40 to column 14, line 4. Applicants respectfully traverse this ground of rejection. It is respectfully submitted that Flom et al. does not disclose means for stabilizing a beating heart, but rather a defibrillation device 140, see column 13, line 40 and Fig. 7. It is further respectfully submitted that reference numeral 160 refers to another defibrillation device, but that wire elements 142,144 are not disclosed as being used with such device. The wire elements 142,144 that are included with defibrillation device 140 of Fig. 7 are not stabilization means, but rather electrodes that have a flexible conductive material 146 connected therebetween.

In addition to these distinctions, to still further clearly define over Flom et al., claim 215 has been amended above to further recite that the means for stabilizing comprises a pair of spaced contact members including a continuous length of shape memory material. It is respectfully submitted that the electrodes 142, 144 are not formed of a continuous length of shape memory material.

Accordingly, in view of the above amendments and remarks, the Examiner is respectfully requested to reconsider and withdraw the rejection of claim 215 under 35 U.S.C. 102(e) as being anticipated by Flom et al. (U.S. Patent no. 5,904,711), as being inappropriate.

**Conclusion**

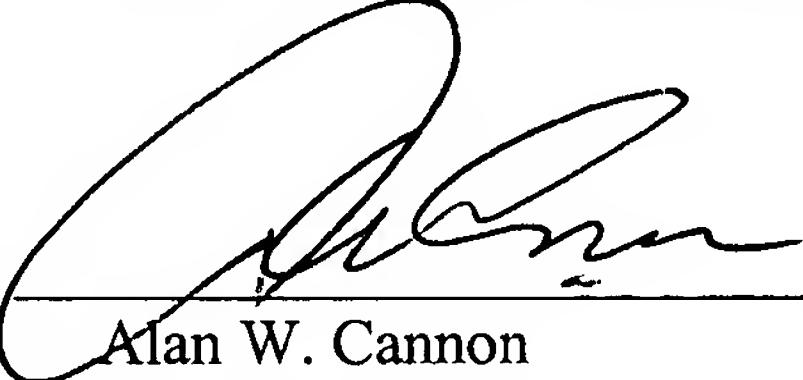
Applicants submit that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone the undersigned at the number provided.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-2653, order number G UID-005CON6.

Respectfully submitted,  
LAW OFFICE OF ALAN W. CANNON

Date: 12/19/06

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